IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 7212
Mark Thompson, et al.	Examiner: JACOBS, LASHONDA T.
Application No.: 10/032,796	Technology Center/Art Unit: 2157
Filed: December 26, 2001	APPELLANTS' BRIEF UNDER 37 CFR §41.37
For: FORMS AUDITING SYSTEMS AND METHODS	

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Commissioner for Patents
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Sir:

Further to the Notice of Appeal dated July 17, 2008 for the above-referenced application, Appellants submit this Brief on Appeal.

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1. REAL PARTY IN INTEREST

At the time of the filing of this Appeal Brief, The Western Union Company is the real party in interest for this appeal.

2. RELATED APPEALS AND INTERFERENCES

A previous Appeal Brief was filed in this Application on February 14, 2008. In response thereto, the Office reopened prosecution with a new Office Action mailed April 30, 2008 ("Office Action"), specifying a new grounds of rejection.

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

3. STATUS OF CLAIMS

Claims 1-15 were originally filed in the application on December 26, 2001. Claim 16 was added by Amendment dated June 6, 2005. Claims 1-16 stand rejected by the Examiner.

Claims 1-16 are believed improperly rejected and are the subject of this Appeal. A copy of the claims as rejected is attached as an Appendix.

4. STATUS OF AMENDMENTS

All Amendments have been entered. No amendments have been filed subsequent to the Office Action mailed April 30, 2008 ("Office Action").

5. SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellants have provided references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. §41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be illustrative in nature only. Claims 1, 11, and 16 are the independent claims.

Claim 1 recites a method for auditing forms. The method includes issuing a request to provide a form identifier that is associated with a form. Original Application, p. 4, ll. 18-24; p. 5, ll. 9-11. The identifier is then received at a host computer. Id., p. 5, ll. 10-12. The host computer verifies whether the identifier is a valid identifier for the form being used. Id., p. 4, ll. 22-23; p. 5, ll. 13-15.

Claim 11 recites a forms auditing system that includes a host computer 12 associated with a database 14. Id., p. 3, ll. 21-25; Fig. 1, ref. nums. 12, 14. The database has a record of a set of forms and a valid identifier for each of the forms. Id., p. 4, ll. 17-23. The host computer is configured to receive an identifier in response to a request to audit a form. Id., p. 4, ll. 18-23; p. 5, ll. 9-12. The host computer verifies whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers in the database. Id., p. 4, ll. 22-23. A record is produced in the database of the comparison. Id., p. 5, ll. 14-16.

Claim 16 recites an alternative forms auditing system that includes a host computer 12 associated with a database 14. Id., p. 3, ll. 21-25; Fig. 1, ref. nums. 12, 14. The database has a record of a set of forms and a valid identifier for each of the forms. Id., p. 4, ll. 17-23. A form identifier is associated with a form. Id., p. 4, ll. 17-23. The host computer is configured to receive an identifier in response to a request to audit a form. Id., p. 4, ll. 18-23; p. 5, ll. 9-12. The host computer verifies whether the identifier is a valid identifier for the audited form by comparing the identifier with valid identifiers in the database. Id., p. 4, ll. 22-23. A record is produced in the database of the comparison. Id., p. 5, ll. 14-16.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground of Rejection I: Claims 1-3, 5-6, and 11- 16 stand rejected under 35 U.S.C §102(e) as anticipated by U.S. Patent No. 6,185,583 to Blando ("Blando"). Pages 2-5 of the Office Action describe the Examiner's current position on this issue.

Ground of Rejection II: Claims 4 and 7-10 stand rejected under 35 U.S.C §103(a) as unpatentable over Blando in view of U.S. Patent No. 5,799,285 to Klingman et al.

("Klingman"). Pages 5-7 of the Office Action describe the Examiner's current position on this issue.

7. ARGUMENT

Ground of Rejection I:

35 U.S.C. §102(e) rejection of claims 1-3, 5-6, and 11-16

The Office Action rejected independent claims 1, 11, and 16 under 35 U.S.C. §102(e) as anticipated by Blando. For a valid anticipation rejection, the Office must show that each limitation from the claims appears in a single piece of prior art. Appellants believe significant limitations from independent claims 1, 11, and 16 are neither taught nor suggested in the references. More specifically, the references cannot be relied upon to teach or suggest a host computer that 1) "receives a form identifier in response to a request to audit a form" or 2) "verifies whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are also found in both independent claims 1 and 11.

The independent claims each set forth a system or method for auditing whether a particular form is valid (e.g., checking to see if the form is being used is the updated or current version of the form). By way of example, the process may be initiated with a request to audit a form (e.g., made by issuing a request to provide a form identifier associated with a form being used). Then, as claim 16 specifically recites, a host computer is configured to "receive the form identifier in response to the request, and to verify whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database." Claims 1 and 11 include a similar limitations.

The Office Action errs in relying on Blando to teach these limitations. While the Office Action identifies similar *terminology* from the claims in Blando, the identified *functionality* of the claims is plainly absent. See Office Action, pp. 2-5, sec. 2, citing Blando, col. 2, ll. 44-54; col. 3, ll. 53-67. Unlike the identified limitations of the claims, the Blando reference instead describes a system for checking to confirm that a form has the correct "type of data and placement of data in the fields." Blando, col. 2, ll. 53-54. Blando also checks to see whether an order type is a valid order type, and determines the required forms to be included in

an order. Id., col. 3, l. 66 - col. 4, l. 9. Blando's process of verifying data in forms by using field identifiers, determining the type of an order, and determining whether the order contains all necessary forms, is different than determining whether the current version is being used by verifying whether a particular *form identifier* is a valid identifier for a particular form.

   1. Receiving Form Identifier: As noted above, in claim 16 a host computer is configured to "receive a form identifier in response to a request to audit a form." The Office Action errs in stating that the "field identifiers" in Blando teach the *form identifier* of the claims. Office Action, p. 5, l. 1, citing Blando, co. 2, ll. 44-54. Blando describes a system including a database holding "field identifiers" that "represent data fields in . . . forms," such as name and address fields. Id. col. 2, ll. 50-52. The system then confirms that the data in such fields is in the proper format. Id. col. 3, ll. 1-17. The field identifiers of Blando simply do not teach or suggest the form identifiers of claims 1, 11, or 16. There is no suggestion in Blando that a form identifier be received in response to a request to audit a form.

   2. Verifying Form Identifier: Claim 16 further recites that a host computer is configured to "verify whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database." The Office further errs in stating that this functionality is found in Blando. In Blando, when the system receives an "***order*** having ***more than one form***," the system determines whether the order type is valid. Emphasis added, Id. col. 3, ll. 60-66. But determining whether an *order type* is *valid* is very different than verifying if the *form identifier* (missing from Blando) is a valid form identifier for the form to be audited. Determining validity of order types is different than verifying whether a particular version of a form is valid.

   Blando goes on to provide that if the order type is valid, the system then determines "which forms correspond to [the] order type" and "checks the received order for the presence of all forms corresponding to the order type." Id. col. 4, ll. 4-8. But again, the functionality of the claims remains absent. In the claims, the host uses a form identifier to verify whether a particular version of a form is valid; whereas in Blando, the system ensures that necessary forms for a particular order type are present.

The Office has clearly erred by asserting that the data validation and order checking process of Blando teaches the forms auditing system of independent claims 1, 11, and 16. The audit of the claims determines whether there is a valid form identifier. In contrast, Blando describes determining whether certain data on a form is valid, whether an order type is valid, and whether an order contains all required forms. Determining the validity of *data* on a form is valid is different from determining the validity of the *form itself*. Determining the validity of an *order type* is different from determining the validity of a *form* included with the order. Determining whether an order *includes* all necessary forms is different from determining whether the version of each of those forms is valid.

The request to audit the validity of a form, and the provision of a form identifier in response thereto, are simply not present in Blando. Blando therefore fails to teach receiving "a form identifier in response to a request to audit a form," as recited in claim 16. Moreover, Blando fails to teach verifying "whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are found in claims 1 and 11, and thus are also absent from Blando

As the cited reference fails to teach or suggest all of the recitations of independent claims 1, 11, and 16, Appellants submit that these claims are allowable. Claims 2-3, 5-6, and 12-15, which depend from these independent claims, are allowable for at least the same reasons. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §102(e) to claims 1-3, 5-6, and 11-16 be reversed.

Ground of Rejection II:
35 U.S.C. §103(a) rejection of claims 4 and 7-10

Claims 4 and 7-10 are rejected under 35 U.S.C. §103(a) as unpatentable over Blando, in view of Klingman. Claims 4 and 7-10 depend from independent claim 1, which is allowable for the reasons given above. Claims 4 and 7-10 are therefore also allowable for at least the reason that they each depend from an allowable base claim. Therefore, Appellants

respectfully request that the rejection under 35 U.S.C. §103(a) to claims 4 and 7-10 be reversed on these grounds.

8. CONCLUSION

For these reasons, it is respectfully submitted that the grounds of rejection should each be reversed.

Respectfully submitted,

Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
61419492 v1

9. CLAIMS APPENDIX

1.   (Previously Presented) A method for auditing forms, the method comprising:

issuing a request to provide a form identifier that is associated with a form;

receiving the identifier at a host computer; and

verifying with the host computer whether the identifier is a valid identifier for the form being used.

2.   (Previously Presented) A method as in claim 1, wherein the request is issued from a terminal having a processor that is in communication with the host computer, and further comprising logging an error if the identifier is not valid.

3.   (Original) A method as in claim 2, wherein the request is sent from the host computer to the terminal.

4   (Original) A method as in claim 1, where the request is issued from a customer service operator over a phone.

5.   (Original) A method as in claim 2, wherein the identifier is received at the host computer from the terminal.

6.   (Original) A method as in claim 1, wherein the host computer includes an associated database, and wherein the identifier is verified by comparing the identifier with a list of valid identifiers in the database.

7.   (Original) A method as in claim 1, further comprising determining whether an appropriate form has already been ordered.

8.   (Original) A method as in claim 7, wherein if an appropriate form has not been ordered, placing an order for an appropriate form.

9.   (Original) A method as in claim 8, further comprising evaluating whether the ordered form is received by a user.

10.   (Original) A method as in claim 9, further comprising transmitting an identifier for a replacement form to the host computer.

11.   (Original) A forms auditing system, comprising:

a host computer; and

a database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms;

wherein the host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers in the database, and to produce a record in the database of the comparison.

12.   (Original) A system as in claim 11, further comprising a terminal having a processor, wherein the terminal is configured to receive the identifier of the form being audited and to electronically send the identifier to the host computer.

13.   (Original) A system as in claim 12, wherein the terminal is configured to produce an audit screen having a region for inputting the identifier.

14.   (Original) A system as in claim 13, wherein the terminal is configured to produce the audit screen based on information sent to the terminal from the host computer.

15.   (Original) A system as in claim 11, wherein the host computer is configured to generate in error report if the identifier of the form being audited is not valid.

16.   (Previously Presented) A forms auditing system, comprising:

a form identifier that is associated with a form;

a host computer; and

        a database associated with the host computer, the database having a record of a set of forms and a valid form identifier for each of the forms;

        wherein the host computer is configured to receive the form identifier in response to a request to audit a form, and to verify whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database, and to produce a record in the database of the comparison.

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10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

None.